THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. JOHNSON,
ROBERT S. KELLER,
GEORGE C. MANTHURUTHIL
and MARVIN L. WILLIAMS

Appeal No. 95-2996
Application 07/791,838[1]

ON BRIEF

Before THOMAS, JERRY SMITH and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-17, which constitute

[1] Application for patent filed November 14, 1991.

all the claims remaining in the application. An amendment after final rejection was filed on August 5, 1994 and was entered by the examiner. This amendment resulted in the removal of a rejection of the claims under the second paragraph of 35 U.S.C. § 112 according to an advisory action mailed on August 17, 1994.

The examiner's answer repeats the rejection of the claims under 35 U.S.C. § 112 without further comment. Appellants' brief includes no comments with respect to the rejection under Section 112 because appellants had been apprised that the rejection had been withdrawn. It appears to us that the rejection of the claims under 35 U.S.C. § 112 was simply repeated from the final rejection by mistake. We reach this conclusion because the examiner has given no notice to appellants why the rejection has been repeated after notice was given that it was withdrawn. Thus, we treat the rejection of the claims under the second paragraph of 35 U.S.C. § 112 as being included in the answer by mistake and as being withdrawn by the examiner as indicated in the advisory action.

The claimed invention pertains to a method and apparatus for designating and retrieving a plurality of particular segments of a multimedia presentation. More particularly, the rate of change of a digital counter of a computer system is determined

(calculated) for each of a plurality of user interface commands. Particular segments of the multimedia presentation are then accessed using the counter, the determined rate of change of the counter and the plurality of commands.

Representative claim 1 is reproduced as follows:

1. A method in a computer system for efficiently designating and retrieving a plurality of particular segments of a multimedia presentation, wherein said multimedia presentation is controlled by said computer system by means of operation of a plurality of user interface commands, each of said plurality of user interface commands having a selected presentation function associated therewith, said method comprising the steps of:

establishing a digital counter within said computer system;

determining a rate of change of said digital counter associated with operation of each of said plurality of user interface commands; and

accessing individual ones of said plurality of particular segments of said multimedia presentation in a random order utilizing said digital counter, said determined rate of change of said digital counter and said plurality of user interface commands.

The examiner relies on the following reference:

Bohrman	5,109,482	Apr. 28, 1992 (filed Feb. 19, 1991)

Claims 1-17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Bohrman taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-17. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in the following two groups: Group I has claims 1-5 and 11-15 and Group II has claims 6-10, 16 and 17. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

Accordingly, we will only consider the rejection against claims 1 and 6 as representative of all the claims on appeal before us.

We consider first the rejection against claim 1 as representative of all the claims within Group I. It is the position of the examiner that Bohrman teaches the use of a counter which has different speeds so that the rate of change of the counter is determined [answer, page 4]. The examiner also asserts that the rate of change of the counter is used for accessing the various segments of the multimedia presentation. The examiner concludes that the invention of claim 1 would have been obvious to the artisan because the relationship between the rate of change of the counter and the associated user interface commands would necessitate that the rate of change of the counter for a given command must be determined in order to access the segment [answer, pages 4-5].

Appellants do not dispute that Bohrman teaches one way in which a user can select segments for display at a presentation. Appellants do dispute, however, that Bohrman has any suggestion regarding the determination of a rate of change of a counter for each of a plurality of user interface commands, and the accessing of segments using the counter, the determined rate of change of

the counter, and the user interface commands [brief, page 5]. According to appellants, Bohrman suggests nothing more than the identification of a start frame and a stop frame for each clip it is desired to present.

The arguments of the examiner and appellants indicate a very fundamental disagreement over whether the invention of claim 1 is suggested by the teachings of Bohrman. It appears to us that this fundamental disagreement is caused primarily by the fact that the word "determining" has standard definitions which are very different from each other. Appellants use the step "determining" in the sense of calculating. That is, when appellants claim "determining" a rate of change of a counter, they actually mean calculating a value for the rate of change of the counter. This is clear from the flow chart of Fig. 5 wherein values of rates of change are calculated and correlated for each user input and ratios of the various rates of change are also calculated for each pair of user input commands. Thus, appellants' arguments in the brief are primarily to make the point that Bohrman never calculates values for the rate of change of the counter. Without these calculated values, appellants' intended invention of accessing various segments for a multimedia presentation without the use of frame numbers or codes cannot be accomplished.

On the other hand, the examiner appears to interpret the word "determining" in the sense of regulating or controlling. That is, each input actuated by a user regulates or controls the speed at which a location counter will count. In this way the rate of change or speed of a counter is regulated or determined by the nature of the relationship between the input command keys and the results they cause to be carried out. Thus, it is the position of the examiner that the rate of change of the counter in Bohrman is implicitly "determined" by the nature of the input command actuated by the user. Therefore, even though Bohrman does not calculate or determine the rate of change of the counter for each of the user interface commands, the examiner insists that the rate of change of the counter is still determined or results from the selection of specific input commands.

When interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor. Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993). It is not entirely clear from the record, but it appears to us that the examiner and the appellants have based their arguments on different definitions of "determining" which,

although inconsistent with each other, are acceptable definitions of "determining" under different circumstances. When a common word in a claim has several definitions, a definition should be selected which is consistent with the disclosed invention and renders the claimed invention operable for its disclosed purpose. In our view, appellants' invention requires that values of the counter rate of change be "determined" by calculation and used to access different segments of a multimedia presentation. We can find no teaching or suggestion in Bohrman to calculate the various values of the counter rate of change.

Although we agree with the examiner that each of the various user commands has a specific, measurable effect on the speed of the counter, the exact values of this measurable effect are usually of no concern to the user. For example, in Bohrman there is no concern as to how fast any counter is counting because the clips are accessed by location markers on the medium and not by the speed with which the markers are accessed. Note that for a videodisc, only the frame number of the "in point" and the frame number of the "out point" are relevant. Likewise, for a CD-ROM, only the address of the "in point" and the address of the "out point" are relevant [see Fig. 8]. The user in Bohrman does not care how fast a counter is counting but only that the in point and out point "counts" are recognized.

For the reasons just discussed, we are of the view that the very linchpin of appellants' claimed invention is in the step of "determining" or calculating values of the rate of change of a counter for each of a plurality of user interface commands. When the claim is properly interpreted in this manner, it is clear that Bohrman does not "determine" a rate of change of the counter in the manner disclosed and intended by appellants. The examiner's rejection of claim 1, therefore, fails to address the significant difference between the recitations of claim 1 and the teachings of Bohrman.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc.

v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Since we have determined that the examiner's interpretation of claim 1 is incorrect and does not properly address the differences between claim 1 and Bohrman, the rejection as formulated by the examiner fails to establish the required prima facie case of the obviousness of claim 1. Therefore, we do not sustain the rejection of claim 1 or the rejection of claims 2-5 and 11-15 which are grouped therewith.

We now consider the rejection of claim 6 as representative of all the claims in Group II. Although directed to a slightly different feature of the invention, claim 6 also recites the step of "determining" the rate of change of a counter associated with each of the user interface commands. For the same reasons we discussed above, Bohrman does not teach or suggest this step of determining when it is given its proper interpretation in the claim. The examiner's separate comments directed to

the rejection of claim 6 do not overcome the noted deficiencies in the teachings of Bohrman. Therefore, we also do not sustain the rejection of claim 6 and claims 7-10, 16 and 17 which are grouped therewith.

In summary, we have not sustained the rejection of any of the claims on appeal as formulated by the examiner. Accordingly, the decision of the examiner rejecting claims 1-17 is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge)

JERRY SMITH
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

LEE E. BARRETT
Administrative Patent Judge)

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